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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,930	07/18/2002	Thomas W. Bakker	W422.312-8	2676

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KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

BOMAR, THOMAS S

ART UNIT PAPER NUMBER

3672

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,930

Applicant(s)

BAKKER, THOMAS W.

Examiner

Shane Bomar

Art Unit

3672

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26,28-40,43,45-48,51 and 52 is/are allowed.
- 6) ☒ Claim(s) 1,2,11,19,20,27,41,42,44,49 and 50 is/are rejected.
- 7) ☒ Claim(s) 3-10,12-18 and 21-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This paper is in response to the pre-amendment filed 28 October 2003 that crossed in the mail with the First Office Action mailed 12 November 2003, which is hereby vacated.

Specification

2. The disclosure is objected to because of the following informalities: on page 4, line 16 the recitation of "senseso" should most likely be --sense so--; on page 8, line 24, the recitation of "proved" should most likely be --provided--; on page 12, line 9, the recitation of "an other" should most likely be --another--; on page 14, line 29, the mud flow is said to be indicated by arrows P and P1, while the drawings show P and P'.

Appropriate correction is required.

Claim Objections

3. Claims 2, 20, 27, and 44 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The ranges of rotation set forth in these claims encompass the range of 360 degrees already presented in claims 1, 19, 26, or 43.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 11, 19, 20, 27, 41, 42, 44, 49, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3672

6. The recitations of “ a drive mechanism for the drill is connected to the ground” in claim 1 and “connections for connecting the ground to a drive mechanism for a drill” in claim 19 appear to be inaccurate. Perhaps the applicant meant to use --tube-- in the place of “ground”.

7. Claim 11 is indefinite and appears to be improperly dependent from claim 1 since the pre-selected angular range of rotation includes less than 360 degrees, which is below the range of at least 360 degrees set forth in claim 1.

8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 20, 27, and 44 recite the broad recitation less than 1800 degrees, and the claim also recites preferably less than 1080 degrees and less than 720 degrees, which are the narrower statements of the range/limitation. Claims 11, 41, 42, 49, and 50 recite the broad limitation less than 360 degrees, and the claims also recite preferably less than 180 degrees, which is the narrower statement of the range/limitation.

Allowable Subject Matter

9. Claims 26, 28-40, 43, 45-48, 51, and 52 are allowed.
10. Claims 3-10, 12-18, and 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter: In GB patent 596,715, Allard teaches a method and apparatus for axially moving a tube in a borehole in a series of alternating, angularly opposite, rotating movements within a limited angular range of rotation of less than 180 degrees. In US patent 5,101,913, Stockley et al teach a method and apparatus for axially moving a tube in a borehole wherein a drill is used to of which the rate of material removal is independent of the direction or speed of rotation of the tube. However, the prior art of record, either alone or in combination, does not teach that the tube is moved within a limited angular range of rotation that comprises at least one full rotation of 360 degrees, as currently claimed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cherrington et al, Djurovic, Leturno, Peck et al, Strong et al, Tschirky, and Winfree teach various methods for casing while drilling. Pruet teaches a chamber for maintaining drilling fluid circulation while attaching pipe joints together. Fuller and Wallace teach the use of rotary tables and downhole motors in combination.

Art Unit: 3672

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 703-305-4849. The examiner can normally be reached on Monday - Thursday from 7:00am to 4:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4198.

David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb
February 2, 2004